REMARKS

Upon entry of this amendment, claims 1-29 are pending. Claims 1 and 8 have been amended.

Amendments to the Claims

Support for the amendments can be found in the specification, particularly on pages 15, 24 and 30-31 of the specification. No new matter has been added.

Rejections under 35 U.S.C. § 103(a)

Claims 1-29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. U.S. Publication No. 2004/0161690 to Sakurai et al., further in view of U.S. Patent No. 5,859,071 to Young et al. and over U.S. Publication No. 2004/0137321 to Savaria et al. individually. For the following reasons, Applicant respectfully submits that the present invention is not obvious under 35 U.S.C. § 103(a) and requests reconsideration and withdrawal of this rejection.

In order to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicants respectfully submit that the amendments to the claims render the Examiner's objections moot and request the Examiner to reconsider the rejections. Claims 1 and 8 now recite "wherein content of said acrylonitrile-butadiene-styrene resin in the total amount of the acrylonitrile-butadiene-styrene resin and the recovery polyethylene terephthalate being in the range of 20 to 70% by mass." None of the references above either individually or in combination teach an acrylonitrile-butadiene-styrene resin comprising 20% to 70% by mass. Each of the examples provided by the Examiner on pages 3 and 4 of the Office Action require 90% by mass resin. Therefore, Sakurai et al. does not motivate one of skill in the art to provide an acrylonitrile-butadiene-styrene resin in the range of 20% to 70% by mass in the total amount of the acrylonitrile-butadiene-styrene resin and the recovery polyethylene terephthalate.

In addition, Young et al. is cited again as acknowledging that there has been increasing interest in the recycling of the commingled plastics waste of automobiles. The different engineering plastics used in various parts of an automobile include polycarbonate, nylons, polyethylene terephthalate, acrylonitrile-butadiene-styrene, etc." Thus, it is concluded that "in view of the common use of the polyethylene terephthalate and acrylonitrile-butadiene-styrene alloy mixture in recording mediums, as shown by the various references above, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a scrap or waste product polyethylene terephthalate moiety in the production thereof since such has been the primary focus of the industry to employ waste product bottle or polyethylene terephthalate for use in secondary compositions or products." However, once again, there is absolutely no teaching or suggestion by Young et al. to provide a casing material for recording media composed of an alloy of polyethylene terephthalate and a polyacrylonitrile-butadiene-styrene copolymer.

As discussed above, Sakurai et al. do not teach or suggest a casing material for recording media comprising an alloy of polyethylene terephthalate and a polyacrylonitrile-butadiene-styrene copolymer wherein content of said acrylonitrile-butadiene-styrene resin in the total amount of the acrylonitrile-butadiene-styrene resin and the recovery polyethylene terephthalate being in the range of 20 to 70% by mass. Young also fails to teach these elements of Applicant's claims. There is absolutely no suggestion or motivation to modify or combine these reference teachings. There is also no reasonable expectation of success in achieving the invention as claimed when the cited references are modified or combined. The teaching or suggestion to make the claimed combination and there reasonable expectation of success must be found in the prior art and not based on Applicant's disclosure as has been done in the Office Action. Finally, the references, even combined, do not teach or suggest all of Applicant's claim limitations, as amended. Unless all the elements are taught by the references, there can be no success in modifying them.

Applicant also requests clarification with regard to several references to the term "anticipation" on pages 4 and 5 of the Office Action. The rejection appears to be based on obviousness (see pages 2 and 5), however, the Examiner also appears to reject certain claims based on "anticipation." To establish anticipation of the present invention, a reference must disclose the invention as set forth in the claim: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." M.P.E.P. §2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 814

F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). As also set forth in M.P.E.P. §2131, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully submits that Sakurai et al. and Young et al. fail to teach each element of the present invention. Specifically, the Examiner notes that the articles of claims 1-29 are prepared with the same components "except for the fact that the polyethylene terephthalate was retrieved from a recovery method." Therefore, the Examiner provides that each element of the claims is not set forth in the claim, and therefore cannot be anticipated by Sakurai et al. Furthermore, as noted above, Young also fails to teach the elements of a casing material for recording media comprising an alloy of polyethylene terephthalate and a polyacrylonitrile-butadiene-styrene copolymer. Hence, both Sakurai et al. and Young et al. cannot anticipate the present invention.

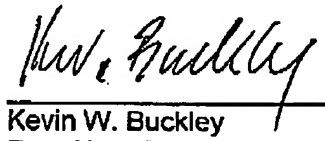
With regard to Savaria et al., that reference does not provide a resin, much less an acrylonitrile-butadiene-styrene resin. When obviousness is based on the modification of a single reference, there must be some suggestion or motivation to modify the teachings of that reference. *C R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225 (Fed. Cir. 1998). Because Savaria et al. do not teach or suggest a resin and do not provide one of skill in the art motivation to modify the reference to include a resin, the reference does not render the present invention obvious.

Thus, at the time the present invention was made, none of the references cited teach or describe all of the limitations claimed by Applicant in independent Claims 1, 8, 9, 10, 15, 22 and 24 and the claims depending therefrom. It would therefore not have been obvious to one of ordinary skill in the art to provide a casing material for recording media comprising an alloy of polyethylene terephthalate and a polyacrylonitrile-butadiene-styrene copolymer. Accordingly, Applicant's invention as claimed is not obvious under § 103 (a).

CONCLUSION

Prompt and favorable consideration of this application, as amended, is respectfully requested. Applicants believe that there is no fee due at this time. However, any deficiency or overpayment may be charged to Deposit Account No. 19-3140.

Respectfully submitted,



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